

Remarks**I. Status of the Application**

Claims 1-32 are pending in the application. Claims 1-32 have been rejected. Claims 1, 11, 13-15, 17, 27, and 29-31 have been amended. Claims 2, 4, 9, 12, 18, 20, 25, and 28 have been cancelled. Claims 33-35 are new.

II. Claims Rejections - 35 U.S.C. § 112

Claims 2, 4, 18, and 20 were rejected under 35 U.S.C. 112, second paragraph, as being allegedly indefinite. Claims 2, 4, 18, and 20 have been cancelled.

III. Claims Rejections - 35 U.S.C. § 102**A. Beneteau**

Claims 1-6, 9-11, 16-22, 25-27, and 32 have been rejected under 35 U.S.C. 102(b) as being allegedly anticipated by U.S. Patent No. 5,077,916 (Beneteau). Applicant has amended claims 1, 11, 17 and 27, and respectfully traverses the rejection. Claims 2, 4, 9, 18, 20, and 25 have been cancelled.

The invention of amended claim 1 is directed to an outsole for a shoe that comprises a frame portion comprising a first material, and one or more insert portions comprising a second material. A surface of the insert portion(s) comprises a plurality of air-filled cushioning modules and a plurality of parallel, hollow, air-filled ribs (separate from the modules) that are oriented perpendicular to the toe-to-heel direction of the outsole. The presence of both ribs

and cushioning modules on the insert portion of the outsole advantageously ensures that the outsole bends in a natural fashion as a user walks, and also cushions the user's foot.

Beneteau discloses a sole comprising two layers made of different materials: (A) a bottom layer of a first material which is said to be firm and strong, and is provided with solid projections for bearing against the ground disposed around the periphery of the sole; and (B) a top layer of a second material which is said to be flexible and resilient, having flexible projections which project beneath the bottom layer by passing through openings in the bottom layer (Abstract).

Nowhere does Beneteau teach or suggest an outsole with an insert portion having a surface which defines a plurality of "hollow, air-filled cushioning modules" and a plurality of "hollow, air-filled ribs" oriented perpendicular to the heel-to-toe direction of the outsole, where the ribs are separate from the cushioning modules, as required by amended claim 1. Beneteau instead discloses a "top layer" having a series of projections which project through openings in a bottom layer (col. 3, lines 50-67). According to Beneteau, all of the "projections" have the same construction and general shape. Specifically, the projections are solid, and shaped in the form of "folds constituting indentations running transversely relative to the longitudinal axis of the shoe." (col. 3, lines 60-62). Thus, Beneteau fails to teach or suggest an insert portion whose surface defines "hollow, air-filled cushioning modules" and "hollow, air-filled ribs" separate from the cushioning modules, as recited by amended claim 1. Accordingly, amended claim 1, together with its dependent claims (3, 5-6, 10-11, and 16) are patentable over Beneteau.

Amended claim 17 and amended claim 1 share similar features. Accordingly, for the reasons stated above, amended claim 17, together with its dependent claims (19, 21-22, 26-27, and 32), are patentable over Beneteau.

B. Gross

Claims 1-6, 9-12, 15-22, 25-28, 31, and 32 were rejected under 35 U.S.C. 102(b) as being allegedly anticipated by U.S. Patent No. 5,267,791 (Gross). Applicant has amended claims 1, 11, 15, 17, 27, and 31, as discussed above, and respectfully traverses the rejection. Claims 2, 4, 9, 12, 18, 20, 25, and 28 have been cancelled.

Gross discloses a shoe sole having foam-filled independently compressible regions that extend through a midsole and beyond an outsole bottom (Abstract). However, Gross fails to teach or suggest an outsole with an insert portion with a surface defining a plurality of “hollow, air-filled cushioning modules” and a plurality of “hollow, air-filled ribs” that are oriented perpendicular to the heel-to-toe direction of the outsole and are separate from the modules, as required by amended claim 1. At best, Gross discloses a forward, foam-filled “insert” projecting through a midsole, and through an outsole in a ball-strike region, and a rear “insert” projecting through the midsole and outsole in a heel-strike region (col. 6, lines 50-61, Fig. 9). Neither of these “inserts” comprises both “hollow, air-filled cushioning modules” and “hollow, air-filled ribs”, as recited by amended claim 1. Accordingly, amended claim 1, together with its dependent claims (3, 5-6, 10-11, and 15-16), are patentable over Gross.

Amended claim 17 and amended claim 1 share similar features. Accordingly, for the reasons stated above, amended claim 17, together with its dependent claims (19, 21-22, 26-27, and 31-32), are patentable over Gross.

IV. Claim Rejections - 35 U.S.C § 103

A. Rejection over either Gross or Beneteau

Claims 7, 8, 23, and 24 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over either Gross or Beneteau. Applicant respectfully traverses the rejection. Claims 7 and 8 depend from amended claim 1. Claims 23 and 24 depend from amended claim 17. As set forth above, amended claims 1 and 17 are patentable over both Beneteau and Gross. Accordingly, claims depending from amended claims 1 and 17, including claims 7, 8, 23 and 24, are also patentable over the cited art.

B. Rejection over Beneteau in view of Wilson

Claims 12-15 and 28-31 were rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Beneteau in view of U.S. Patent No. 2,090,881 (Wilson). Applicant has amended claims 13-15 and 29-31 and respectfully traverses the rejection. Claims 12 and 28 have been cancelled.

Claims 13-15 depend from amended claim 1 and therefore include all of the features of amended claim 1. Claims 29-31 depend from amended claim 17 and therefore include all of the features of amended claim 17. Furthermore, as discussed above, Beneteau fails to teach or suggest an outsole with an insert portion having a surface with both “cushioning modules” and “ribs,” as required by amended claims 1 and 17. Wilson also fails to teach or suggest this feature. Accordingly, claims 13-15 and 29-31 are patentable over the cited art.

V. New Claims

New claim 33 defines a sole for a shoe comprising an outsole and an insole board layer that is adjacent to an upper surface of the outsole. The outsole in turn comprises a frame portion and an insert portion. The insert portion includes a plurality of concave hollows in its upper surface such that when the adjacent insole board is placed in proximity thereto, the concave hollows are enclosed to form a plurality of hollow, air-filled modules. Support for new claim 33 is found at pages 8-9 and in Fig. 4, for example. Neither Beneteau nor Gross teaches or suggests an outsole comprising a plurality of air-filled modules formed by the placement of an insole board layer in proximity to an insert layer comprising a plurality of concave hollows, as claimed.

New claim 34 defines an outsole for a shoe comprising a frame portion and at least one insert portion molded to the frame portion. The frame portion comprises a first material having a first density and the insert portion comprises the same material with a different density. The insert portion additionally includes cushioning modules on its surface. Support for new claim 34 is found on page 5, third paragraph, for example. Neither Beneteau nor Gross teaches or suggests an outsole comprising a frame portion comprising a first material having a first density and an insert portion comprising the same material with a different density, as claimed.

New claim 35 defines an outsole for a shoe comprising a frame portion making up at least a substantial portion of the outsole's periphery, and an insert portion comprising a plurality of cushioning modules, such that the bottom of the cushioning modules are substantially flush with the bottom of the frame portion to provide an integrated, stable bottom surface for the outsole. Support for new claim 35 is found at page 8, last paragraph,

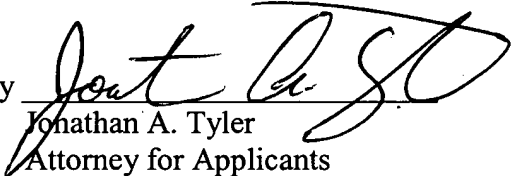
for example. Neither Beneteau nor Gross teaches or suggests an outsole having a frame portion and an insert portion having a plurality of cushioning modules, wherein the bottom of the cushioning modules are substantially flush with the bottom of the frame portion, as claimed. No new matter is added.

VI. Conclusion

In view of the foregoing, each of claims 1, 3, 5-8, 10-11, 13-17, 19, 21-24, 26-27, and 29-35, as amended, is believed to be in condition for allowance. Accordingly, consideration and/or reconsideration of these claims, as appropriate, is requested and allowance of the application is earnestly solicited.

Respectfully submitted,

By



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